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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 09/936,016      | 12/11/2001  | Andrew George Cordiner |                     | 9273             |

21890 7590 10/03/2003

PROSKAUER ROSE LLP  
PATENT DEPARTMENT  
1585 BROADWAY  
NEW YORK, NY 10036-8299

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| EXAMINER |
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YOON, TAE H

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| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |   |  |
|------------------------------|-------------------------------|---|--|
| <b>Office Action Summary</b> | Application No.<br>09/936,016 | Applicant(s)<br>CORDINER, ANDREW GEORGE |  |
|                              | Examiner<br>Tae H Yoon        | Art Unit<br>1714                        |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

First, the examiner points out that the recited Dv.99, Dv.50 and particle sizes thereof have little probative value since the agglomerated particles no longer have the recited properties due to the fusion of film-forming polymeric matrix. For example, agglomerated particles of the colored film-forming base component comprising a pigment and a polyester and the uncolored film-forming component comprising a polyester would be particles of a pigment and a polyester. Note that the claim is silent as to the size of said agglomerated particles, and thus any particle size meets the instant invention. Also, an invention in a product-by-process claim is a product, not a process. See In re

**Brown**, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and **In re Thorpe**, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985).

Claims 1-29, 31, 34, 35, 37-57 and 59-68 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morgan et al (EP 0 372 860, EP 0 459 048 or US 5,319,001).

The examiner points out EP'860 patent since three patents are almost same.

EP teaches the instant powder coating comprising particles comprising a pigment and a polyester resin and a coated substrate thereof in abstract and examples and at page 3, lines 23-34. The instant kit is seen in figures, and the use of 3 to 10 basic colors is taught at page 3, lines 40-54.

Thus, the instant invention lacks novelty.

Claims 1-68 are rejected under 35 U.S.C. 103(a) as obvious over Morgan et al (EP 0 372 860, EP 0 459 048 or US 5,319,001).

The instant invention further recites different curing agents, incompatible resins and mica. However, EP'860 teaches different curing agents for a carboxy-functional and hydroxy-functional polyester and mixtures of binders (such as polyester, fluoro-resins or polyphenylene sulfide which are incompatible) at page 3, line 56 to page 4, line 10. Example (page 8, line 14) shows filler comprising barites and talc.

It would have been obvious to one skilled in the art at the time of invention to utilize different curing agents, incompatible resins and mica in Morgan et al since

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Morgan et al teach the use of different curing agents and incompatible resins and since mica is the art well known filler absent showing otherwise.

Claims 1-29, 31, 32, 34, 35, 37-56, 61 and 63-68 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Seo et al (US 6,130,281).

Seo et al teach the instant powder coating comprising particles comprising a pigment and a polyester resin and a coated substrate thereof in abstract and examples. A polyester resin mixture having different functional groups is taught at col. 3, lines 31-34. Thus, the instant invention lacks novelty.

Claims 1-56, 58 and 61-68 are rejected under 35 U.S.C. 103(a) as obvious over Seo et al (US 6,130,281).

The instant invention further recites different curing agents, incompatible resins and mica. However, Seo et al teach different curing agents for a carboxy-functional polyester and mixtures of film-forming resins including incompatible resins at col. 3, lines 6-60. Various fillers or extender pigments such as talc or silica are taught at col. 3, lines 66-67.

It would have been obvious to one skilled in the art at the time of invention to utilize different curing agents, incompatible resins and mica in Seo et al since Seo et al teach the use of different curing agents and incompatible resins and since mica is the art well known filler absent showing otherwise.

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Claims 1-29, 31, 34, 35, 37-56, 61 and 63-68 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Itakura et al (US 6,146,145).

Itakura et al teach the instant powder coating comprising particles comprising a pigment and a polyester resin and a coated substrate thereof in abstract and examples. Smoothing agent (col. 12, line 44 and table on col. 16) meets the instant texturing additive. Thus, the instant invention lacks novelty.

Claims 1-31, 34, 35, 37-56, 58 and 61-68 are rejected under 35 U.S.C. 103(a) as obvious over Itakura et al (US 6,146,145).

The instant invention further recites incompatible resins and at least 3 uncolored film-forming component. However, Itakura et al teach film-forming resins including incompatible resins and mixtures thereof at col. 5, lines 46-53 and col. 7, lines 56-60.

It would have been obvious to one skilled in the art at the time of invention to utilize incompatible resins or at least 3 uncolored film-forming component in Itakura et al since Itakura et al teach the use of different resins including incompatible resins and mixtures of resins absent showing otherwise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tae H Yoon  
Primary Examiner  
Art Unit 1714

THY/September 29, 2003